



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

SW

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,190	09/29/2000	Stephen F. Gass	SDT 316	9029
27630	7590	12/17/2004	EXAMINER	
SD3, LLC 22409 S.W. NEWLAND ROAD WILSONVILLE, OR 97070			ASHLEY, BOYER DOLINGER	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/676,190

Applicant(s)

GASS, STEPHEN F.

Examiner

Boyer D. Ashley

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-30 and 35-40 is/are pending in the application.
- 4a) Of the above claim(s) 28 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-30 and 35-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/18/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Art Unit: 3724

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/12/04 has been entered, wherein claim 27 was amended and claims 36-40 were added. Claims 25-27, 29-30, and 36-40 are currently pending while claims 28, 35 are withdrawn from consideration as being drawn to non-elected invention.

SPECIAL CIRCUMSTANCES OF THIS APPLICATION:

Even if a copending application is listed on this instant application or other copending applications or patents and the material information is technically of record in one or more parent or copending applications, the unusually large number of applicant's cases in varying stages of the examination process might result in one or more parent applications not being readily available for review, or material information of record not being readily apparent. Moreover, applications, which may not have any direct relationship, as continuing applications, to other copending applications by the same assignee may not be readily apparent due to the unusually large number of applicant's cases.

Applicant should point out such material information to the examiner of the instant application if the criteria for materiality applies, and if the examination record provides applicant reason to believe such information has not been considered by the examiner. This should include a listing of all related cases whether previously filed, recently filed, currently being filed, or patented.

If, to the best of applicant's knowledge, applicant has no previous patent or copending application, which would meet the definition of "material," applicant is requested to make a statement of that fact of record.

Any parent application labeled as a CIP or Divisional is assumed to claim a patentably distinct invention from the claims of this application and therefore the issue of double patenting has not been considered and the rights to priority are limited to the common disclosed subject matter unless it is brought to the examiners attention that some claims are not distinct.

37 CFR 1.56. Duty to disclose information material to patentability.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 25-26 and 36-38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4-5, 7, and 20-35 of copending Application No. 10/051,782. Although the conflicting claims

Art Unit: 3724

are not identical, they are not patentably distinct from each other because the claims 1, 4-5, 7 and 20-35 of '782 anticipate the claims of 25-29, 30, and 36-40.

For example, claim 25 of the instant application requires, *inter-alia*, a saw with a detection system and reaction system with a brake for contacting the blade wherein at least a fraction of the angular momentum of the blade is used for urging the axis of the blade away from the work surface. Claim 1 of '782 includes, *inter-alia*, a miter saw with a detection system and reaction system with a brake for contacting the blade wherein at least a fraction of the angular momentum of the blade is used for urging the axis of the blade away from the work surface.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 27, 29-30, and 39-40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4-5, 7, and 20-35 of copending Application No. 10/051,782 in view of Yoneda.

Copending application '782 discloses the invention substantially as claimed except for the detection system only detects a dangerous condition between the user and the blade instead of contact between the user and the blade. However, Yoneda discloses that it is old and well known in the art to use detection systems with cutting tools that detect contact between a user and a blade for the purpose of prevent injury to the user while prevent premature stopping of the tool. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to a

Art Unit: 3724

detection system that senses contact instead of dangerous conditions in order to prevent injury to the user and to prevent premature stopping of the tool.

This is a provisional obviousness-type double patenting rejection.

5. Claims 25-26 and 36-38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5, 8, and 15 of copending Application No. 10/052,273. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims 5, 8 and 15 of '273 anticipate the claims of 25-26 and 36-40.

For example, claim 25 of the instant application requires, *inter-alia*, a saw with a detection system and reaction system with a brake for contacting the blade wherein at least a fraction of the angular momentum of the blade is used for urging the axis of the blade away from the work surface. Claim 5 of '273 includes, *inter-alia*, a miter saw with a detection system and reaction system with a brake for contacting the blade wherein at least a fraction of the angular momentum of the blade is used for urging the axis of the blade away from the work surface.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 27, 29, 30, and 39-40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5, 8, and 15 of copending Application No. 10/052,273 in view of Yoneda.

Copending application '273 discloses the invention substantially as claimed except for the detection system only detects a dangerous condition between the user

Art Unit: 3724

and the blade instead of contact between the user and the blade. However, Yoneda discloses that it is old and well known in the art to use detection systems with cutting tools that detect contact between a user and a blade for the purpose of prevent injury to the user while prevent premature stopping of the tool. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to a detection system that senses contact instead of dangerous conditions in order to prevent injury to the user and to prevent premature stopping of the tool.

This is a provisional obviousness-type double patenting rejection.

7. Claims 25-27, 29-30, and 36-40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/643,296. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims 1-10 of '296 anticipate the claims of 25-27, 29-30 and 36-40.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3724

9. Claims 36 and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bosten et al., or Meredith in view of Lokey and Friemann et al. or Yoneda and Terauchi.

Bosten et al. and Meredith et al. both disclose the invention substantially as claimed except for the detection system and the brake system; but includes, e.g., a base (16), a work surface (18/20), rotatable blade (36), a motor (34), a pivot joint (30), and a support arm (28).

The modified devices of lack the detection and reaction system, wherein the detection/reaction system is configured to detect a dangerous condition between a person and the blade or configured to detect contact between a user and the blade. The brake system engages the blade upon detection of the dangerous condition which tends to urge the blade away from the cutting area.

Lokey discloses that it is old and well known in the art to use detection and braking system for the purpose of preventing injury to a user. Friemann et al. and Yoneda both discloses that it is old and well known in the art to use braking systems with cutting tools that brake the cutting tool upon detection of contact between the user and the blade. Terauchi discloses that it is old and well known in the art to use safety systems that includes immediate stopping of the blade or retraction of the a blade when the blade contacts a workpiece holder for the purpose of preventing damage or further damage to the workpiece holder.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a detection system and a braking system, as

Art Unit: 3724

taught by Lokey, Friemann et al., Yoneda and Terauchi with the devices of Bosten et al. or Meredith et al. such that the blade is urged away from the work surface upon detection of contact between the user and the blade in order to prevent injury to the user by retracting the blade upon detection of a dangerous condition.

Response to Arguments

10. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

It should be noted that regardless of the declarations the examiner agrees with applicant's comment found on pages 11-14 of the previous responds, with regard to the rejection of claims 25-27 and 29-30. More specifically, the applied prior art references fail to disclose or suggest a reaction system that includes a brake for decelerating the blade as well as for using a fraction of the angular momentum of the blade to generate a force tending to urge the axis around with the blade rotates away from the work surface when the brake decelerates the blade. Terauchi teaches using a motor to return the blade instant of using the angular momentum created by rotation blade. It is believe that the previous rejection was lacking because it failed to disclose any teaching of angular momentum to urge the blade away from the cutting zone.

Applicant contends that the double patenting rejections are improper for the following reasons: 1) the co-pending claims address later-developed species claims, that is, the claims of the later filed applications are more narrow than the claims of the instant application. Therefore, the claims in the instant application are not obvious in light of the copending applications because the invention did not exist at the time of the

Art Unit: 3724

invention of the instant claims was made or at the time. In this case, the applicant could not have filed the claims in the same application and the inventive entities are different; 2) applicant further states that claims in the instant application may be encompasses in the copending application claims but that in of itself is insufficient to support a double patenting rejection because the issues of claim dominance and double patenting must not be confused. MPEP 804; and 3) applicant also contends that two-way obviousness analysis should be applied for these rejections because the applicant could not have filed the claims in a single application.

Although, the examiner sympathizes with the applicant regarding the double patenting rejections, the examiner can find no support for applicant's arguments in the MPEP.

It should be noted that applicant appears to be confusing the different types of double patenting as well as the requirements for obviousness type double patenting with regard to 35 USC 103. The fact that the improvement was later developed and sought does not prevent double patenting. There is no requirement that double patenting rejection must to be limited to applications that are filed concurrently nor is there any requirement limiting double patenting based upon filing dates of the application, that is, it does not matter which one is filed first. The fact that the improvement was not known to the applicant at the time of invention/filing of the earlier filed application does not preclude double patenting. The facts are, that the instant application has broad claims, which are readable on by the subsequent applications. If the instant application claims were issued without a terminal disclaimer the potential

Art Unit: 3724

problem of dual ownership of patents claiming the same broad language could exist.

The claims of later filed applications would infringe the claims of the instant application.

Applicant's comments regarding different inventive entities noted; however, it should be noted that the instant application has at least one common inventor and has common ownership with the later filed applications and therefore, is a proper double patenting rejection. See the charts in early part of section 804.

Applicant's comments regarding dominance do not apply because the presence of domination does not preclude double patenting; but in any event the double patenting rejections were not made under *In re Schneller*. This is not an *In re Schneller* type situation, the broad claims of the instant application do not read on the more narrower claims of the later filed applications.

Applicant's comments regarding two-way obviousness also do not apply. Although, it is true that applicant could not have filed the claims in later filed applications in the instant application there are two requirements for two-way obviousness. In this case, there is no administrative delay. The office did not prevent the earlier filed application from issuing nor did the office prevent the earlier application from being prosecuted. It should be noted that normal prosecution of an application does not constitute delaying. Therefore, only a one-way test is required.

Applicant's contends that the claims in co-pending application 10/052,273 recite structures for urging the blade away from the cutting area instead of stopping the motion of the cutting tool in to the cutting area. The examiner respectfully disagrees. Although the two applications do have different focuses, the fact that '273 reads on the instant

Art Unit: 3724

claims is not diminished. A blade, which is urged away from the cutting area is clearly prevented from moving toward the cutting area and therefore, the motion toward the cutting area, by the blade is stopped.

Applicant further contends that the provisional double patenting rejection should be withdrawn because section 804 I.B. states that when the only rejections remaining are the provisional double patenting rejections then the rejection should be withdrawn in one application to allow the application. It should be noted that double patenting rejections are not the only rejections remaining but in any event the Applicant is misinterpreting said section of the MPEP. The specific section MPEP does not apply in case because there is no two way double patenting. For this section to apply there has to be provisional double patenting rejection to "convert" in to a double patenting rejection.

11. For the reasons above, the grounds of rejection are deemed proper.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 571-272-4502. The examiner can normally be reached on Monday-Thursday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3724

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Boyer D. Ashley
Primary Examiner
Art Unit 3724

BDA
December 12, 2004